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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/788,677	02/27/2004	Michael D. Smith	418268004US	3591
45979 7590 12/29/2009 PERKINS COIE LLP/MSFT P. O. BOX 1247 SEATTLE, WA 98111-1247				
EXAMINER				
EVANS, KIMBERLY L				
ART UNIT		PAPER NUMBER		
3629				
NOTIFICATION DATE		DELIVERY MODE		
12/29/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentprocurement@perkinscoie.com

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### Office Action Summary

**Application No.**

10/788,677

**Applicant(s)**

SMITH ET AL.

**Examiner**

KIMBERLY EVANS

**Art Unit**

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## DETAILED ACTION

### Response to Amendments

1. This action is in reply to the application filed on March 9, 2009.
2. Claims 1-27 are currently pending and have been examined.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-5, 7-23, 26, and 27 are rejected as being anticipated by Burrows et al., US Patent Application Publication No US 2004/0093371 A1.
5. With respect to Claims 1, 11, 12, and 22,  
Burrows discloses the following limitations,
  - *acquiring a ticket from a ticketing entity, the ticket having a value specified by a sender of a message; adding the acquired ticket to the message; and forwarding the message with the added ticket to a recipient, (see at least paragraph 35: "...a Ticket Server provides a network service that can issue "tickets" and can verify and cancel previously issued tickets. A ticket*

may be implemented as a small binary value (e.g., in the range of about 500 bits), typically represented as a base-64 string so that it can readily be shipped through web pages, URLs, or e-mail messages.....")

- *ticketing entity charges sender for value of ticket* (see at least paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire tickets charged to A's account.....")
- *a processor and memory* (see at least paragraph 300: "...environments, and/or configurations that may be suitable for use with the invention include, but are not limited to, personal computers (PCs), automated teller machines, server computers, hand-held or laptop devices, multi-processor systems, microprocessor-based systems, programmable consumer electronics, network PCs, appliances, lights, environmental control elements, minicomputers, mainframe computers and the like. As discussed above, the invention may be practiced in distributed computing environments where tasks are performed by remote processing devices that are linked through a communications network/bus or other data transmission medium. In a distributed computing environment, program modules may be located in both local and remote computer storage media including memory storage devices, and client nodes may in turn behave as server nodes. ...")
- *wherein upon receiving the message, the recipient can conditionally, redeem the value of the ticket from the ticketing entity* (see at least paragraph 35: "...a request for a new ticket will result in a "challenge" from the Ticket Server; the correct response to this challenge will provide the requestor with the desired ticket. Tickets might have various values, or might be restricted to particular uses. When a ticket has been issued, it can be passed around (for example, with some request or attached to some e-mail). The recipient of a ticket can call the Ticket Server to verify and cancel the ticket, thereby making the originator pay for the request. The recipient can also credit the ticket back to the originator, making the request free.....")

6. With respect to Claims 2 and 13,

Burrows discloses all of the above limitations, Burrows further discloses,

- *the acquired ticket includes a sender authenticating code so that a mail server that receives the message can authenticate the sender of the message.* (see at least paragraph 289: "...The key K.sub.A authenticates client "A" so that nobody else can acquire tickets charged to A's account...")

7. With respect to Claim 3,

Burrows discloses all of the above limitations, Burrows further discloses,

- *a block of tickets is acquired at a time from the ticketing entity* (see at paragraph 273: "...The Ticket Server creates Ticket Kits TK such that the ticket constructed by replacing TK.P with X, for any X for which TK.P(X) is true, will be a valid ticket ...")

8. With respect to Claims 4, 14, and 15,

Burrows discloses all of the above limitations, Burrows further discloses,

- *each ticket of the block includes a code from a sequence of codes generated from a start code using a one-way function.*
- *the sender messaging server generates the sequence of codes and includes them in issued tickets*(see at least paragraph 59: "...In the case where the problem is defined by, say, a message to be sent, S finds some x'.sub.0 by search from x.sub.L found from x.sub.0, and then R checks that the x'.sup.0 does indeed lead to the right x.sub.L after L forward steps, and that the path has the required property. ...")

9. With respect to Claim 5,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein the tickets are added to messages in reverse order of generation of their codes.*(see at least paragraph 14: "...When sending a message, the message is handed to a delivery

agent that communicates with the mail server at the ISP. Receiving messages is basically the reverse process.....")

10. With respect to Claims 7, 20, and 27,

Burrows discloses all of the above limitations, Burrows further discloses,

- *the recipient's mail system can validate the ticket with the ticketing entity before presenting the message to the recipient* (see at least paragraph 18: "...If a Ticket Kit is issued, the client is able to construct a valid ticket from a correct answer to the challenge and the data in the Ticket Kit. A challenge is described as possibly including a CPU bound task, a memory bound task, a task that can be solved only by a human, or monetary payment....")

11. With respect to Claims 8, 17, and 21,

Burrows discloses all of the above limitations, Burrows further discloses,

- *the recipient's mail system can automatically discard messages with ticket values below a threshold value set by the recipient.* ( see at paragraph 236: "...if a message arrives not from a white list member and without a ticket, or if the sender's address is invalid (so that no bounce message can be sent), or if an invalid or previously cancelled ticket is provided at any stage, then the ISP 30 silently discards the message. The same is true of messages that exist for too long without a ticket being submitted to the ISP. ...")

12. Burrows discloses all of the above limitations, Burrows further discloses,

- *when the recipient redeems the ticket, an account of the sender is debited.* (see at least paragraph 229: "...Requestors with a positive balance in their account can call the "Request Ticket" operation and will be given a new, valid, unused, ticket without any need to perform a challenge (and their account can be debited). ...")

13. With respect to Claim 16,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein a sender messaging client generates the sequence of codes and provides a terminal code of the sequence to the sender messaging server. (see at least claim 10, column 12, lines 53=54: "... an identification number of the sending system...")*

14. With respect to Claim 19,

Burrows discloses all of the above limitations, Burrows further discloses,

- *the recipient messaging system presents messages to the recipient in an order based on the ticket values of the messages.(see at least paragraph 25: "...The method includes the steps of receiving a request for access to the resource from a client, and requiring the client to show that it has computed a predefined memory-bound function before providing access to the resource. ...")*

15. With respect to Claim 26,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein the entity that maintains the sender's account transfers the value to the entity that maintains the recipient's account. (see at least paragraph 229: "...Finally, whoever receives the ticket and performs the "Cancel Ticket" operation (whether client "B" or the ISP, discussed below in connection with FIG. 2B) can choose to refund the ticket to the originator by invoking the "Reuse Ticket" operation at the Ticket Server 20. This causes the Ticket Server to credit the ticket to the original requestor's account. Requestors with a positive balance in their account can call the "Request Ticket" operation and will be given a new, valid, unused, ticket without any need to perform a challenge (and their account can be debited). ...")*

**Claim Rejections - 35 USC § 103**

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- i. Determining the scope and contents of the prior art.
- ii. Ascertaining the differences between the prior art and the claims at issue.
- iii. Resolving the level of ordinary skill in the pertinent art.
- iv. Considering objective evidence present in the application indicating obviousness or nonobviousness.

18. Claim 6 is rejected under 35 USC 103(a) as being unpatentable over Burrows in view of Couelgnoux, US Patent Application Publication No US 2006/0053279 A1.

19. With respect to Claim 6,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein a mail server is provided with an end code of the sequence of codes and determines whether a ticket of the message includes a code from which the end code can be derived.*

(see at least paragraph 27: "...authorized by the receiver's filter, can secretly compute an



authorization code unique to the filter, sender pair that it appends to the message sent to the receiver. The receiver's receiving agent can depend on a third party to compute the authorization code independently and compare it to the one produced by the sender's sending agent. If the comparison fails, the message is not displayed to the receiver as intended by the sender. ...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the system of Couelgnoux because the filter process is an efficient means for reducing undesirable electronic messages.

20. Claims 24 and 25 are rejected under 35 USC 103(a) as being unpatentable over Burrows in view of Huang US Patent Application Publication No US 2003/0231207 A1.

21. With respect to Claims 24, and 25,

Burrows discloses all of the above limitations, Burrows further discloses,

- *wherein a sender's account and a recipient's account are maintained by the same entity*
- *a sender's account and a recipient's account are maintained by different entities*

(see at least paragraph 23: "...An object of embodiments of the present invention is to provide a system and method for automatically accessing all the e-mail accounts of a particular user no matter where hosted.. ...")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the method and systems for reducing spam of Burrows with the personal email system and method of Huang because it is an efficient way for automatically adjusting the protocols based on a particular provider sites.

### **Conclusion**

22. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Kimberly L.**

**Evans** whose telephone number is **571.270.3929**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **John Weiss** can be reached at **571.272.6812**.

23. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free). Any response to this action should be mailed to: **Commissioner of Patents and Trademarks**, P.O. Box 1450, Alexandria, VA 22313-1450 or faxed to **571-273-8300**. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**: Randolph Building 401 Dulany Street, Alexandria, VA 22314.

/KIMBERLY EVANS/Examiner, Art Unit 3629

/JOHN G. WEISS/

Supervisory Patent Examiner, Art Unit 3629

